

U.S. Patent Application No. 10/561,632
Attorney Docket No. 10191/4152
Response to Final Office Action of December 14, 2007

AMENDMENTS TO THE DRAWINGS:

The attached Replacement sheets of drawings including Figures 1 to 5 replace the original sheets containing Figures 1 to 5. No new matter has been added. Approval and entry are respectfully requested.

Attachments: two (2) Replacement Sheets

REMARKS

Claims 14 to 21 and 23 to 25 are now pending and being considered in the present application.

Applicants respectfully request reconsideration of the present application in view of this response.

The drawings were objected to as lacking labels. The accompanying Replacement Sheets of the drawings obviate the present objections. Approval and entry are respectfully requested. Withdrawal of the objections is therefore respectfully requested.

As to section nine (9) of the Final Office Action, claims 14 to 20 were rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claim 14 (and the dependent claims) are to a simulation system and a method for performing a useful, concrete, and tangible utility and are therefore statutory. By using such a system or method using distinct memory locations instead of shared ones, the process of model-to-code transformation, compilation, and linkage, and executable download need not be repeated. Further, signal connecting ports can be established, modified, or removed (even during a running experiment) without perceptible delay.

Applicants do not understand why these issues are being raised in view of the recent Precedential Opinion of the Board of Patent Appeals and Interferences, *Ex parte Carl A. Lundgren* (paper no. 78), Appeal No. 2003-2088 (U.S. Patent Application Serial No. 08/093,516) (case Heard April 20, 2004).

Still further, it is respectfully submitted that claim 14 (system), does satisfy § 101 since it is directed to a system and since there is utility. The Lundgren opinion and MPEP (2106 and 2107) regarding the Examination Guidelines for the utility requirement address these issues. It is also respectfully submitted that the reasons advanced in support of the rejection are simply not supported by either the Examination Guidelines or more importantly the case law, and that a *prima facie* case has not been presented as required by Sections 2106 and 2107 of the MPEP.

In this regard, the Board of Patent Appeals — in reversing another Examiner as to the law of State Street — has stated that claimed subject matter having a “practical application” is § 101 statutory subject matter if it represents a “useful, concrete and tangible result” under State Street, and has further stated that the Federal Circuit’s reasoning in State Street is “intended to be broadly construed”. See *Ex parte Donner*, 53 U.S.P.Q.2d 1699, 1702 (Bd. Pat. App. & Int. 1999).

Nevertheless, while the rejections may not be agreed with, to facilitate matters, claim 14 has been rewritten without prejudice to provide for “including a processor and computer readable medium having program code that is executable by the processor.” Withdrawal of the rejections is therefore respectfully requested.

As to section ten (10) of the Final Office Action, claims 14 to 21 and 23 to 25 were rejected under 35 U.S.C. § 112, ¶ 2, as indefinite.

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, ¶ 2 is appropriate, an analysis as to why the phrase(s) used in the claim are “vague and indefinite” should be included in the Office Action. *M.P.E.P. § 2173.02*. The Examiner has not included any such analysis. Instead, the Examiner asserts that it is unclear how the features of claims 14 to 21 and 23 to 25 operate, which is completely unrelated to whether the phrases or terms of a claim are vague and indefinite. In this regard, the claims only recite the invention, so that their purpose is not to explain how the invention works, since that is left to the specification. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1558 (Fed. Cir. 1983). Since claims 14 to 21 and 23 to 25 are clear and are not ambiguous, they are definite.

As to section eleven (11), claims 14 to 21 and 23 to 25 were rejected under 35 U.S.C. § 102(e) as anticipated by Brayton et al., U.S. Patent No. 6,823,280.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Final Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and See Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted

that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

As to claims 14, 21 and 25, the “Brayton” reference does not identically disclose (nor suggest) the claim feature of “plurality of simulation processes with **corresponding memory modules** and interface modules” The Final Office Action merely points to simulation module 120, in Figures 3 and 4 of the “Brayton” reference and asserts that there are a “plurality simulation databases/memories where data from the databases are transferred/downloaded.” However, “Brayton” does not disclose “**corresponding memory modules** and interface modules” as provided for in the context of the claims as explained in the specification, the corresponding memory modules facilitate dynamic module interconnections. “[I]nter-module communication is performed in an explicit manner by using distinct memory locations instead of shared ones and copying or replicating signal values from one memory location to another when needed.” (See Specification, page 4, lines 13 to 15.) This is even expressed as a claim feature in which “the memory modules include distinct memory locations for inter-module communication.” The “Brayton” reference does not provide corresponding memory modules to facilitate such a purpose. The Final Office Action asserts that the text at column 6 line 58 to column 7 line 10 of the “Brayton” reference discloses that “system modules are dynamically reconfigurable for communication via distinct memory locations.”

To the extent that the Office is implying that the “database tables to store test and test parameters” corresponds to a memory location, it does not identically disclose the corresponding memory modules as presented in the context of the claims. The database of the reference is for “test cases, expected results for test comparison and exception generation.” (“Brayton” reference, column 7 lines 4 & 5). Thus, a distinct memory location for inter-module communication is not disclosed.

Further, the “Brayton” reference does not identically disclose (or suggest) the claim feature in which “system modules are dynamically reconfigured with each other.” Dynamic reconfiguration of the system modules enables several benefits as explained in the specification, including putting portions of the entire model into operation little by little during a running experiment. The dynamic updates in “Brayton” concern “stor[ing] tests and test parameters” and “modify[ing] parameters for existing tests.” Thus, models are not dynamically modified but tests and test parameters are modified. Persons skilled in the art are aware of the difference between a model and a test parameter. For instance, a model may be a representation of a system, and tests or test parameters may be conditions under which the model is tested.

Accordingly, claims 14, 21 and 25 are allowable, as are their respective dependent claims.

CONCLUSION

It is therefore respectfully submitted that claims 14 to 21 and 23 to 25 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

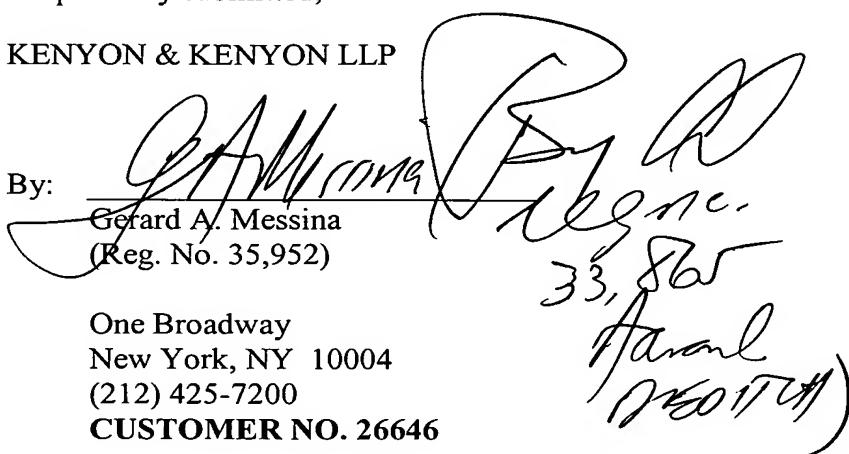
KENYON & KENYON LLP

Dated: 3/14/08

By:

Gerard A. Messina
(Reg. No. 35,952)

One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO. 26646


R.R.
Reg. No.
33,865
Aaron
2601741)